REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 10, 12-19, 36, 38-44, 52-61, and 68-87 are pending in the present application; Claims 10, 12, 14-17, 19, 36, 38, 40-44 and 52-61 having been amended and Claims 68-87 having been added by way of the present amendment.

In the outstanding Office Action, Claims 10, 12-19, 36, 38-44 and 52-61 were rejected under 35 U.S.C. §103 as being unpatentable over Kraslavsky et al (Kraslavsky) in view of Cohn et al (Cohn). This rejection is respectfully traversed.

Initially, it is noted that each of the independent claims has been amended to remove the "Internet" and the "Internet electronic mail" limitation. Now, the independent claims require the use of "electronic mail." The use of the Internet is included in added dependent Claims 68-71.

Regarding the prior art rejection, the claims were rejected over the combination of Kraslavsky and Cohn. While Banno et al (U.S.P. 4,876,606) has been cited as showing a particular feature, there is no explanation as to how Banno et al can be combined with Kraslavsky and Cohn nor any motivation provided relating to such a combination. Moreover, Banno et al is not listed in ¶3 on p.2 of the Office Action as part of the 35 USC § 103 rejection. Accordingly, it does not appear as if Banno et al is formally utilized in the outstanding rejection and is therefore not further addressed.

An argument presented below with regard to the 103 rejection is that one of ordinary skill in the art would not combine Kraslavsky and Cohn in order to achieve the claimed invention. Kraslavsky and Cohn have a number of features which would prevent them from being combined in

order to achieve the claimed invention. The outstanding Office Action on pages 9-10 has cited at least four CCPA and Federal Circuit cases related to the concept of why it would be permissible to combine references, and that there is no requirement for the features of a secondary reference to be bodily incorporated into the structure of the primary reference. However, an argument being made against the combination of Kraslavsky and Cohn is ***not*** that the references must be bodily combinable or that the references are limited to specific structures individually disclosed. The arguments set forth include the position that the concepts disclosed within the patents do not lend themselves to being combined with one another, as such a combination destroys important features of the references.

If the next action is not an allowance, the Examiner is requested to specifically explain why the arguments set forth below are not persuasive instead of merely citing four court cases.

Technical arguments related to the result of the combination of the patents used to reject the claims and other issues have been addressed in an attached Declaration prepared in conformance with the requirements of 37 C.F.R. §1.132 by an independent expert, Carlton P. Tolsdorf, Jr. The arguments set forth in the Tolsdorf Declaration cannot be ignored, and must be considered by the Examiner.

I. EMAIL IS TOO SLOW AND NOT INTERACTIVE ENOUGH TO BE UTILIZED IN THE SYSTEM OF KRASLAVSKY

As explained in the Tolsdorf, Jr. Declaration, interactivity and fast bi-directional communication between a printer and a controlling computer is important and essential to the invention of Kraslavsky. This is a clear and undisputable feature of Kraslavsky.

Back in June of 1995, one of ordinary skill in the art would not think to modify Kraslavsky

to utilize an email format, as disclosed in Cohn because the interactivity and rapid communication features of Kraslavsky would be lost, and no feature which is not already present in Kraslavsky would be obtained. Please see further comments in the Tolsdorf, Jr. Declaration with regard to this feature.

If the Examiner does not agree with this conclusion that (1) interactivity and fast bi-directional communication is important to Kraslavsky, and that (2) using an email format or Internet email would destroy such interactivity and fast bi-directional communication, the next Official Action is requested to explain how it is obvious and permissible to destroy the important and essential feature of Kraslavsky pertaining to the interactivity and bi-directional rapid communication through the use of email or Internet electronic mail.

II. COHN TEACHES THE USE OF INTERNET EMAIL FORMAT WHEN THERE IS A PROBLEM WITH DIVERSE COMMUNICATION PROTOCOLS AND FORMATS; KRASLAVSKY DOES NOT TEACH SUCH DIVERSE PROTOCOLS AND FORMATS

Cohn uses different formats for various types of messages such as video, email, text, voice, etc. Because of the use of these different formats, all messages are encapsulated in a standard message wrapper to form a message for transport and storage within the communication system. See Cohn at col. 16, lines 11-17. However, because Cohn relates only to a printing system and printers only need to receive information to be printed in a single format, no one of ordinary skill would look at the teachings of Cohn related to the standard message wrapper, and apply such a teaching to Kraslavsky, because Kraslavsky does not have diverse types of communication protocols or messages.

The independent expert Tolsdorf, Jr., as set forth in the attached Tolsdorf, Jr. Declaration, also supports this conclusion.

Based on at least the reasons set forth in this section, one of ordinary skill in the art would not modify Kraslavsky based on what is taught in Cohn. If the outstanding rejection is maintained, the Examiner is requested to explain why a patent such as Kraslavsky which does not need or utilize diverse communication protocols would need to use a standard message wrapper such as email.

III. THE EXAMINER'S RATIONALE FOR MODIFYING KRASLAVSKY TO ALLOW THE GLOBAL TRANSFER OF MESSAGES IS INSUFFICIENT

The outstanding Office Action explains that the motivation for modifying Kraslavsky to use an Internet electronic mail message format as disclosed in Cohn is "because it would allow the message to be transferred globally between any devices." A question which is raised by this statement of motivation is what the Office Action means by "any devices." To what devices does the Examiner refer? Kraslavsky is only concerned with monitoring and control of a printer. There is no need to deal with any other machine. Moreover, Kraslavsky uses a SCSI device and indicates that the system can serve additional printers and peripherals. Kraslavsky at column 8, lines 4-8. Thus, Kraslavsky is capable of performing all desired communications using the SCSI communication format, and global communication between the peripherals and the computer can already occur.

As stated in the Tolsdorf, Jr. Declaration, it is the opinion of Mr. Tolsdorf that the Examiner's motivation to allow the message to be transferred globally is not an issue or problem and it is unclear what this statement of motivation means. As there is no motivation or need or desire to combine Cohn with Kraslavsky, the obviousness rejection must fail.

As the Examiner's sole motivation for combining Kraslavsky and Cohn is to achieve global communication, then an explanation from the Examiner of the operation of such global

communication is in order, and also an explanation as to how Kraslavsky does not have global communication is also requested by the applicant.

IV. THE COMBINATION OF COHN AND KRASLAVSKY DOES NOT RESULT IN THE CLAIMED INVENTION

Certain pending claims, such as Claims 68-71, require the transmission of an Internet electronic mail which has been transmitted over the Internet. Neither Cohn nor Kraslavsky disclose the use of the Internet. While Cohn teaches the use of an Internet email format, there is no disclosure or suggestion within either Cohn or Kraslavsky to use the Internet.

Moreover, as the Examiner has not cited any printer or other business office device which discloses the use of the Internet to control and/or monitor and/or diagnose a printer, the claims which recite the use of the Internet are patentable over the prior art as the outstanding Office Action provides no prior art which utilizes the Internet, as claimed.

As the prior art used to reject the claims is lacking the feature of the Internet, then the combination of such prior art is also lacking any use of the Internet. Thus, the outstanding rejection must be withdrawn. See also the Tolsdorf, Jr. Declaration which supports this argument.

V. IT IS NOT CLEAR FROM THE OFFICE ACTION HOW THE COMBINED SYSTEM OF KRASLAVSKY AND COHN WOULD OPERATE

Cohn teaches the use of a standard message wrapper which encapsulates ***all*** received messages with the standard message wrapper. Cohn at col. 16, lines 12-18. Thus, if the teachings of the message format disclosed in Cohn were applied to the system of Kraslavsky, ***all*** communication between the printer and a controlling computer would have an Internet electronic mail message format.

As explained in the Tolsdorf, Jr. Declaration, such a system does not make sense and would not be obtained or constructed by one of ordinary skill in the art. If all messages to the printer in Kraslavsky were constructed in accordance with the common wrapper, the resulting system would transmit all data including the print jobs and data to be printed using such an electronic mail format. Tolsdorf, Jr. explains that it would not have been practical or obvious to transmit all communications in Kraslavsky to the printer. However, this is what is taught in and required by Cohn.

If the resulting system of the Cohn and Kraslavsky patents does not encapsulate all information including the print information in a common wrapper, then how would the resulting system operate? If the Examiner is combining the references such that the system resulting from the combination of Cohn and Kraslavsky is a hybrid system such that some information is encapsulated in the electronic mail format and other information is not, then there is no motivation to provide such a system as the reference does not provide such a motivation for developing a hybrid communication system.

For all of the above reasons, one of ordinary skill in the art would not and could not combine Cohn with Kraslavsky and therefore, the rejection under 35 U.S.C. §103 should be withdrawn.

VI. LONG-FELT BUT UNRESOLVED NEED

Also included herewith is a second Declaration under 37 C.F.R. §1.132 which demonstrates a long-felt but unresolved need based on objective facts which cannot be ignored. Such facts show over an extended period of time that there were numerous attempts to provide the most inexpensive remote diagnostic system. The Declaration also explains, based on the inventor's

experience, that the use of telephone lines does not solve the long-felt need because of the extra cost associated with using telephone lines. Moreover, the Declaration explains that the individual components of the claims were available at the time in which the original application was filed (June of 1995).

The Declaration of Motoyama explains that the use of telephone lines in a remote diagnostic system does not satisfy the long-felt but unresolved need, and the declaration is applicable to all claims which utilize electronic mail, which is every claim. Moreover, the Motoyama Declaration is applicable to claims which recite the use of a Local Area Network. The added claims pertaining to the use of a Local Area Network and also claims which recite that the electronic mail message is received without using a telephone line are supported by the originally filed specification at at least page 28, lines 16-24. Moreover, the drawings also support such claim limitations.

Based on the arguments set forth herein and the two attached Declarations, it is firmly believed that the rejections under 35 U.S.C. §103 should be withdrawn.

Consequently, in light of the above discussion and in view of the present amendment, the present application is in condition for formal allowance and an early and favorable action to that effect is requested.

Respectfully submitted,

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Marked-Up Copy
Serial No: 08/738,659
Amendment Filed on:
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IN THE TITLE

Please amend the title as follows:

[METHOD AND SYSTEM FOR DIAGNOSIS AND CONTROL OF MACHINES USING CONNECTION AND CONNECTIONLESS MODES OF COMMUNICATION]

--METHOD AND SYSTEM FOR TRANSMITTING INFORMATION FROM SENSORS USING ELECTRONIC MAIL--.

IN THE CLAIMS

Please amend Claims 10, 12, 14-17, 19, 36, 38, 40-44, and 52-61 as follows:

--10. (Four times amended) A method for communicating between a monitored device and a monitoring device, comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device; and

transmitting the information through [Internet] electronic mail from the monitoring device to the monitored device[,

wherein said information is contained in an Internet electronic mail message].

12. (Twice Amended) A method according to claim [10] 68, wherein the step of transmitting the information from the monitoring device comprises:

transmitting the information to the monitored device which is a business office device.

13. (Unchanged) A method according to claim 12, wherein the step of transmitting the information to the monitoring device comprises:

transmitting the information to one of a copier, a facsimile machine, and a printer.

14. (Three Times Amended) A method according to claim [10] 68, further comprising the steps of:

receiving the transmitted information by the monitored device; and

transmitting, through the Internet [electronic mail], an Internet electronic mail message from the monitored device to the monitoring device containing status information of the monitored device, in response to the transmitted information from the monitoring device.

15. (Amended) A method according to claim [10] 68, wherein the transmitting step comprises:

transmitting the information from the monitoring device to a plurality of monitored devices including the monitored device.

16. (Three Times Amended) A method for communicating between a machine and a monitoring device, comprising the steps of:

determining status information using at least one of a mechanical and electrical sensor; and

transmitting [, through Internet electronic mail,] an [Internet] electronic mail message from the machine to the monitoring device containing the status information.

17. (Three Times Amended) A method according to claim [16] 69, further comprising the step of:

analyzing the status information by the machine,

wherein the status information is transmitted in the Internet electronic mail message from the machine when the status information is analyzed and determined to be within a standard operating range.

18. (Unchanged) A method according to claim 17, further comprising the steps of:

determining status information which is outside of normal operating parameters exists in the machine using at least one of the mechanical and electrical sensor; and

transmitting a connection-mode message from the machine to the monitoring device containing the status information which is outside of the normal operating parameters.

19. (Three Times Amended) A method according to claim 17, wherein the step of transmitting from the machine to the monitoring device comprises:

transmitting, through the Internet [electronic mail], the Internet electronic mail message from the machine which is a device selected from the group consisting of a copier, a facsimile machine, and a printer, to the monitoring device.

36. (Four Times Amended) A system for communicating between a monitored device and a monitoring device, comprising:

means for determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device; and

a transmitter of the monitoring device which transmits the information through [Internet] electronic mail from the monitoring device to the monitored device[,

wherein said information is contained in an electronic mail message].

38. (Twice Amended) A system according to claim [36] 70, wherein the monitored device is a business office device.

39. (Unchanged) A system according to claim 38, wherein the business office device is one of a copier, a facsimile machine, and a printer.

40. (Three Times Amended) A system according to claim [36] 70, wherein the monitored device further comprises:

a receiver which receives the transmitted information; and

a transmitter which transmits, through the Internet [electronic mail], an Internet electronic mail message from the monitored device to the monitoring device containing status information of the monitored device, in response to the transmitted information from the monitoring device.

41. (Twice Amended) A system according to claim [36] 70, wherein the transmitter of the monitoring device comprises:

a transmitter which transmits the information from the monitoring device to a plurality of monitored devices including the monitored device.

42. (Three Times Amended) A system for communicating between a machine and a monitoring device, comprising:

sensors within the machine which sense status information to be transmitted to the monitoring device; and

a transmitter of the machine which transmits [, through Internet electronic mail,] the status information using an [Internet] electronic mail message from the machine to the monitoring device.

43. (Twice Amended) A system according to claim [42] 71, further comprising:

means for analyzing the status information by the machine,

wherein the status information is transmitted using the transmitter of the machine when the status information is analyzed and determined to be within a standard operating range.

44. (Amended) A system according to claim 43, further comprising:

means for determining status information which is outside of normal operating parameters exists in the machine using said sensors; and

a transmitter configured to transmit [transmitting] a connection-mode message from the machine to the monitoring device containing the status information which is outside of the normal operating parameters.

52. (Twice Amended) A method according to claim [10] 68, wherein the transmitting step comprises:

transmitting the [information through] Internet electronic mail message which [, wherein said Internet electronic mail message] includes an identifier followed by an "@" symbol followed by a domain name.

53. (Twice Amended) A method according to claim 52, wherein the transmitting step further comprises:

transmitting the [information through] Internet electronic mail message which [, wherein said Internet electronic mail message] includes a description of an encoding type of the Internet electronic mail message.

54. (Twice Amended) A method according to claim 10, wherein the transmitting step comprises:

transmitting [the information through Internet electronic mail, wherein] said Internet electronic mail message [is transmitted] through a firewall of a network which includes the monitored device.

55. (Twice Amended) A method according to claim 54, wherein the transmitting step further comprises:

transmitting [the information through Internet electronic mail, wherein] said Internet electronic mail message <u>which</u> includes an identifier followed by an "@" symbol followed by a domain name.

56. (Twice Amended) A method according to claim 55, wherein the transmitting step further comprises:

transmitting [the information through Internet electronic mail, wherein] said Internet electronic mail message <u>which</u> includes a description of an encoding type of the Internet electronic mail message.

57. (Twice Amended) A system according to claim [36] <u>70</u>, wherein the transmitter comprises:

a device configured to transmit [the information through Internet electronic mail, wherein] said Internet electronic mail message <u>to include</u> [includes] an identifier followed by an "@" symbol followed by a domain name.

58. (Twice Amended) A system according to claim 57, wherein the transmitter further comprises:

a device configured to transmit [the information through Internet electronic mail, wherein] said Internet electronic mail message to include [includes] a description of an encoding type of the Internet electronic mail message.

59. (Twice Amended) A system according to claim [36] 70, wherein the transmitter comprises:

a device configured to transmit [the information through Internet electronic mail, wherein] said Internet electronic mail message [is transmitted] through a firewall of a network which includes the monitored device.

60. (Twice Amended) A system according to claim 59, wherein the transmitter further comprises:

a device configured to transmit [the information through Internet electronic mail, wherein] said Internet electronic mail message to include [includes] an identifier followed by an "@" symbol followed by a domain name.

61. (Twice Amended) A system according to claim 60, wherein the transmitter further comprises:

a device configured to transmit [the information through Internet electronic mail, wherein] said Internet electronic mail message to include [includes] a description of an encoding type of the Internet electronic mail message.

Please add new Claims 68-87 as follows:

68. (New) A method according to claim 10, wherein said step of transmitting comprises:

transmitting the information through an Internet electronic mail message over the Internet from the monitoring device to the monitored device.

69. (New) A method according to claim 16, wherein said step of transmitting comprises:

transmitting the information using an Internet electronic mail message through the Internet from the machine to the monitoring device.

70. (New) A system according to claim 36, wherein the transmitter comprises:

a device configured to transmit the electronic mail message and information, using the Internet, as Internet electronic mail from the monitoring device to the monitored device.

71. (New) A system according to claim 42, wherein the transmitter comprises:

a device configured to transmit the information and electronic mail message, using the Internet, as an Internet electronic mail message from the monitoring device to the monitored device.

72. (New) A method according to claim 68, wherein the transmitting step comprises:

transmitting the Internet electronic mail message through a Local Area Network ("LAN").

73. (New) A method according to claim 72, wherein the transmitting step comprises:

transmitting the Internet electronic mail message without using a telephone line.

74. (New) A method according to claim 10, wherein the transmitting step comprises:

transmitting the electronic mail message without using a telephone line.

75. (New) A method according to claim 68, wherein the transmitting step comprises:

transmitting the Internet electronic mail message without using a telephone line.

76. (New) A method according to claim 69, wherein the transmitting step comprises:

transmitting the Internet electronic mail message through a Local Area Network ("LAN").

77. (New) A method according to claim 76, wherein the transmitting step comprises:

transmitting the Internet electronic mail message without using a telephone line.

78. (New) A method according to claim 16, wherein the transmitting step comprises:

transmitting the electronic mail message without using a telephone line.

79. (New) A method according to claim 69, wherein the transmitting step comprises:

transmitting the Internet electronic mail message without using a telephone line.

80. (New) A system according to claim 70, wherein the transmitter comprises:

means for transmitting the Internet electronic mail message through a Local Area Network ("LAN").

81. (New) A system according to claim 80, wherein the transmitter comprises:

means for transmitting the Internet electronic mail message without using a telephone line.

82. (New) A system according to claim 36, wherein the transmitter comprises:

means for transmitting the electronic mail message without using a telephone line.

83. (New) A system according to claim 70, wherein the transmitter comprises:

means for transmitting the Internet electronic mail message without using a telephone line.

84. (New) A system according to claim 71, wherein the transmitter comprises:

means for transmitting the Internet electronic mail message through a Local Area Network ("LAN").

85. (New) A system according to claim 84, wherein the transmitter comprises:

means for transmitting the Internet electronic mail message without using a telephone line.

86. (New) A system according to claim 42, wherein the transmitter comprises:

means for transmitting the electronic mail message without using a telephone line.

87. (New) A system according to claim 71, wherein the transmitter comprises:

means for transmitting the Internet electronic mail message without using a telephone line.--